



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,651	08/10/2001	Travis J. Parry	10012445-1	4435

7590 01/25/2006  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER	
SINGH, SATWANT K	
ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/925,651

Applicant(s)

PARRY, TRAVIS J.

Examiner

Satwant K. Singh

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This is in response to the amendment filed on 06 January 2006.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection. Claim 22 is allowable since the Terminal Disclaimer for application 09/925,651 has been received and approved. The Final Rejection of 02 November 2005 has been withdrawn.

### ***Terminal Disclaimer***

3. The terminal disclaimer filed on 06 January 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of application 09/925,651 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

Art Unit: 2626

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,972,863. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the present application recites: A printing method comprising the steps of: receiving print stream data at a printer; detecting an external network address in the received print stream data; obtaining at least one parameter of a document at the external network address; merging the document into the print stream data to form a modified document; and printing the modified document.

Claim 2 of the present application recites: A method wherein the detecting an external network address step comprises a barcode in the received data and translating the barcode to the external network address.

Claim 1 in the referenced patent recites: the receiving step; detecting and translating the barcode step; merging step; and printing step. The retrieving and selecting step is equivalent to the present application's obtaining step.

It would be obvious to one having ordinary skill in the art that these limitations are variations of each other.

6. Claims 3-19 are rejected for being dependent on a rejected double-patented base claim.

7. Claim 20 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 24 of U.S. Patent No. 6,972,863. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 20 of the present application recites: A program product for printing comprising a computer readable medium having machine readable program code embodied therein to be executed by a computer the machine readable program code comprising: computer code for receiving print stream data at a printer; computer code for detecting an external network address in the received print stream data; computer code for merging the document into the print stream data to form a modified document; computer code for and printing the modified document.

Claim 24 in the referenced patent recites: the receiving code; detecting and translating code; merging code; and printing code. The retrieving and selecting code is equivalent to the present application's obtaining code.

It would be obvious to one of ordinary skill in the art that these limitations are variations of each other.

8. Claim 21 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent No. 6,972,863. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 21 of the present application recites: A system for printing, comprising: a component for receiving print stream data at a printer; a component for detecting an external network address in the received print stream data; a component for obtaining at least one parameter of a document at the external network address; a component for

Art Unit: 2626

merging the document into the print stream data to form a modified document; and a component for printing the modified document.

Claim 31 in the referenced patent recites: the receiving component; detecting and translating component; the merging component; and the printing component. The retrieving and selecting component is equivalent to the present application's obtaining component.

It would be obvious to one having ordinary skill in the art that these limitations are variations of each other.

#### ***Allowable Subject Matter***

9. Claim 22 is allowed. The Terminal disclaimer for application 09/925,650 has been received and entered.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

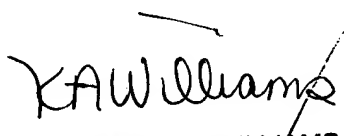
Art Unit: 2626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



sks

Satwant K. Singh  
Examiner  
Art Unit 2626

  
**KIMBERLY WILLIAMS**  
**SUPERVISORY PATENT EXAMINER**